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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,138	10/23/2001	Ralf Eckert	LNUP:112_US_	8044

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George L. Snyder, Jr.
Hodgson Russ LLP
Suite 2000
One M&T Plaza
Buffalo, NY 14203-2391

EXAMINER

NAGPAUL, JYOTI

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,138

Applicant(s)

ECKERT ET AL.

Examiner

Jyoti Nagpaul

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 13-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8 and 13-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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4. **Claims 1-8 and 13-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein in view of Weyrauch.

Bernstein describes a system for performing a plurality of independent analysis procedures simultaneously, each procedure having a tissue sample and at least one process step for operating on that sample. Multiple process steps are done in parallel processes. The system comprises a robotic device for moving the tissue sample to various processing stations (13). The system includes a processor/computer (15), which selects the next tissue sample to move, when to move it, and where to move it. The tissue samples are mounted on sample carriers (slides). The robot moves the slides (540) through a plurality of workstations. There are three types of slide carriers (560, 600 and 630), which are specific to workstations. The robot moves the slides in and out of the slide carriers. (See columns 15-16, column 17, line 37 and column 19, line 39 and column 20, line 27) Bernstein discloses displaying a status overview in the form of an overview graphical depiction indicating, for each individual processing station. The processing stations are represented by corresponding symbols in graphical depiction as shown in Figure 6.

Bernstein fails to disclose automatically monitoring the reagents of processing stations to detect data. The detected data includes data relating to freshness of reagent in each individual processing station. Bernstein also fails to display in a graphical depiction indicating the predefined parameters of reagent.

Weyrauch discloses an automatic chemical analyzer that includes a turntable (11) adapted to hold a plurality of disposable cuvettes (10). An optical

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system (14) adjacent to the turntable can perform analytical absorbance or fluorescence tests on the contents of each cuvette as they are rotated on the turntable. A sample/reagent tray (15) is rotatably mounted about an axis parallel to the turntable axis. A common probe arm (17) pivoted about a third parallel axis mounts a pipette that can be moved along an accurate path intersecting a cuvette access station (A) on the turntable and at least one container access station (C) on the sample/reagent tray for transferring liquids as required by specific test procedures. (See Figure 1-3, Columns 5-6, lines 56-24) The system also includes software, which is programmed to automatically read, identify and monitor different parameters in the system. Specifically, at column 10, lines 43-45, Weyrauch et al. teaches a means for monitoring content of the reagent containers. Weyrauch further includes automatically monitoring reagents of processing stations to detect data including data relating to freshness of reagent in each individual processing station. The system stores the type of reagent as well as its lot code and serial number, plus the volume, working expiration time and status of the container in question. (Col. 56, Lines 48-52) Weyrauch teaches monitoring of physical composition and fill level of reagents in reagent bottles with detectors. The system includes a capacitive sensing system for sensing of liquid levels by use of pipette/detector. Weyrauch also teaches the step of displaying and definable parameters and data detected and data collected from monitoring such as fill level of the reagent, working life of reagent contained in processing station in terms of days since the last reagent change...etc.(See column 33, lines 45-50)

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It would have been obvious to one of the ordinary skill in this art at the time of invention by applicant to modify the system of Bernstein to include the features of Weyrauch in order to monitor physical composition and fill level of the reagent in working stations and graphically display the data from monitoring where the analog representation is a bar graph. Further it would have been obvious to include the step of displaying the definable parameters and data detected and data collected from monitoring such as fill level of the reagent, working life of reagent contained in processing station in terms of days since the last reagent...etc. graphically with symbols to their respective processing stations as used in Bernstein's teachings. It would have been obvious to one of the ordinary skill in this art at the time of invention be applicant to modify the system of Bernstein in order to detect data relating to freshness of reagent in each individual processing station and display a graphical depiction indicating the predefined parameters of reagent and status information where analog representation is a bar graph in order to easily recognize and handle the sample containers in thus facilitating in a increase in efficiency of the process. Such a modified system would have also achieved reproducible treatment results of identical quality. The data obtained in the context of monitoring could have served to initiate or control an automatic refilling or automatic replacement of the reagents.

With respect to Claim 24, automatic refilling would have been obvious as a means to replenish testing materials. Automatically filling would have been obvious as a way to replenish testing materials with out operator intervention. As

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references teach monitoring "freshness" and fill level, re-filling with "fresh" reagent would have been an advanced control option readily contemplated by one of ordinary skill in the automatic analysis art.

Response to Arguments

Applicant's arguments filed on October 18, 2004 have been fully considered but they are not persuasive. With respect to Claim 1, Bernstein describes a system for performing a plurality of independent analysis procedures simultaneously, each procedure having a tissue sample and at least one process step for operating on that sample. Bernstein discloses displaying a status overview in the form of an overview graphical depiction indicating, for each individual processing station. The processing stations are represented by corresponding symbols in graphical depiction as shown in Figure 6. Bernstein fails to disclose a step of displaying parameters of the reagent. However, Weyrauch discloses an automatic chemical analyzer that includes a turntable (11) adapted to hold a plurality of disposable cuvettes (10). Weyrauch further includes automatically monitoring reagents of processing stations to detect data including data relating to freshness of reagent in each individual processing station. The system stores the type of reagent as well as its lot code and serial number, plus the volume, working expiration time and status of the container in question. (Col. 56, Lines 48-52) It would have been obvious to one of the ordinary skill in this art at the time of invention be applicant to modify the system of Bernstein such that the graphical depiction display include predefined

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parameters of the reagent in order to easily recognize and handle the sample containers in thus facilitating in a increase in efficiency of the process.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jill Warden
Supervisory Patent Examiner
Technology Center 1700

JN